



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/922,184	08/02/2001	Edward O. Clapper	42390P11330	7545

21906 7590 03/02/2004

TROP PRUNER & HU, PC  
8554 KATY FREEWAY  
SUITE 100  
HOUSTON, TX 77024

EXAMINER
----------

TIEU, BINH KIEN

ART UNIT	PAPER NUMBER
----------	--------------

2643

26

DATE MAILED: 03/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/922,184

Applicant(s)

CLAPPER, EDWARD O.

Examiner

BINH K. TIEU

Art Unit

2643

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 43-62 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 43-62 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 01/09/2004 has been entered.

As the results, claims 23-42 were cancelled and new claims 43-62 were added as pending claims in this Application.

### ***Claim Rejections - 35 USC § 112***

2. Claims 43-62 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. According to the Specification, lines 20-22 on page 3, the remote websites 18 are data service providers. Since the remote websites are called "Internet providers", they do not provide databases and/or data information services free to Internet users. They are privately provided databases or data information services to their subscribers. Therefore, nowhere in the specification disclosed that the correlated information related to the sender is provided free or publicly by the remote websites. The Applicant is requested to point out wherein the

Art Unit: 2643

specification disclosed that the remote websites 18 are freely or publicly accessed by Internet users.

### *Claim Objections*

3. For the purpose examination only, the Examiner assumed that the remote websites 18 are freely or publicly accessed by Internet users was taught somewhere in the Specification.

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 43, 45-51, 53-55 and 57-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swartz (U.S Pat. #: 6,445,694 as cited in the previous Office Action) in view of Bedrosian et al. (U.S. Pat. #: 6,459,782).

Regarding claim 43, Swartz teach a method comprising:

receiving a communication from a sender, the communication including an audio message and sender identification information;

storing the audio message (col.12, lines 36-59);

searching for correlated information related to the sender, using the sender identification information (col.9, lines 27-39);

storing the corrected information (col.10, lines 45-59).

Art Unit: 2643

It should be noticed that Swartz further teaches the step of searching for searching a phone book database located at the host service location 40 or the correlated information related to the sender entered by the subscriber. Swartz fails to clearly teach such phone book database contained correlated information related to the sender, which is publicly **accessed and searched** by any Internet users. However, Bedrosian et al. ("Bedrosian") teaches the public databases such as white pages for searching correlated information related to the caller (col.5, lines 29-44; col.5, line 63 – col.6, line 2) for purpose of providing more information concerning the caller.

Therefore, it would have been obvious to one of ordinary skill in the art the time the invention was made to incorporate the use of the public databases/white pages contained the correlated information related to the caller and the feature of searching such databases, as taught by Bedrosian, into view of Swartz in order to send said audio message with additional sender information to the receipt.

Regarding claims 45-50, Swartz further teaches limitations of the claims in col.3, lines 39-59; col.6, line 50 – col.7, line 40.

Regarding claim 51, Swartz teaches an apparatus comprising:

a telephone mechanism (i.e., subscriber location as shown at 30 in figure 1) to connect to a network and to receive a communication from a sender, the communication including an audio message and sender identification information; memory to store the audio message (col.12, lines 36-59);

a search directory to search one or more remote sources of information, for correlated information related to the sender (col.9, lines 27-39); and

memory to store the corrected information (col.10, lines 45-59).

Art Unit: 2643

It should be noticed that Swartz further teaches the step of searching for searching a phone book database located at the host service location 40 or the correlated information related to the sender entered by the subscriber. Swartz fails to clearly teach such phone book database contained correlated information related to the sender, which is publicly **accessed and searched** by any Internet users. However, Bedrosian et al. ("Bedrosian") teaches the public databases such as white pages for searching correlated information related to the caller (col.5, lines 29-44; col.5, line 63 – col.6, line 2) for purpose of providing more information concerning the caller.

Therefore, it would have been obvious to one of ordinary skill in the art the time the invention was made to incorporate the use of the public databases/white pages contained the correlated information related to the caller and the feature of searching such databases, as taught by Bedrosian, into view of Swartz in order to send said audio message with additional sender information to the receipt.

Regarding claims 53-54, Swartz further teaches limitations of the claims in figure 10, note col.12, lines 46-54.

Regarding claim 55, Swartz teach an article storing instructions (i.e., software installed at subscriber location as shown at 30 in figure 1, col.3, line 60 – col.5, line 36) that, if executed, enable a system to:

- receiving a communication from a sender, the communication including an audio message and sender identification information;

- storing the audio message (col.12, lines 36-59);

- searching for correlated information related to the sender, using the sender identification information (col.9, lines 27-39);

storing the corrected information (col.10, lines 45-59).

It should be noticed that Swartz further teaches the step of searching for searching a phone book database located at the host service location 40 or the correlated information related to the sender entered by the subscriber. Swartz fails to clearly teach such phone book database contained correlated information related to the sender, which is publicly **accessed and searched** by any Internet users. However, Bedrosian et al. ("Bedrosian") teaches the public databases such as white pages for searching correlated information related to the caller (col.5, lines 29-44; col.5, line 63 – col.6, line 2) for purpose of providing more information concerning the caller.

Therefore, it would have been obvious to one of ordinary skill in the art the time the invention was made to incorporate the use of the public databases/white pages contained the correlated information related to the caller and the feature of searching such databases, as taught by Bedrosian, into view of Swartz in order to send said audio message with additional sender information to the receipt.

Regarding claims 57-62, Swartz further teaches limitations of the claims in col.3, lines 39-59; col.6, line 50 – col.7, line 40.

2. Claims 44, 52 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swartz (U.S Pat. #: 6,445,694) in view of Bedrosian et al. (U.S. Pat. #: 6,459,782) as applied to claims 43, 51 and 55 above, and further in view of McAllister et al. (U.S. Pat. #: 6,442,242 also cited in the previous Office Action).

Regarding claims 44, 52 and 56, Swartz and Bedrosian, in combination, teaches all subject matters as claimed above. Swartz further teaches the database not only storing telephone

Art Unit: 2643

numbers, but also fax and pager numbers and email addresses for forwarding messages to a recipient (col.11, lines 1-7). Swartz fails to clearly teach the features of encoding the audio message; composing an email message that includes the encoded audio message and transmitting the email message to a predetermined email address. However, McAllister et al. ("McAllister") teaches such features in col.8, lines 25-32 for a purpose of delivering the voice messages to designed called party through a data network.

Therefore, it would have been obvious to one of ordinary skill in the art the time the invention was made to incorporate the use of the features of encoding the audio message; composing an email message that includes the encoded audio message and transmitting the email message to a predetermined email address, as taught by McAllister, into view of Swartz in order to forward the voice messages to called party using a data network such as Internet.

### ***Conclusion***

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Bossi et al. (U.S. Pat. #: 6,421,425) also teaches the feature of accessing the Internet for searching one or more websites for public correlated information related to a dialed telephone number dialed by a caller.

### ***Response to Arguments***

4. Applicant's arguments filed 01/09/2004 have been fully considered but they are not persuasive.



In response to the Applicant's arguments raised in the third paragraph, page 6 wherein the Applicant stated as followings:

**“... In on e aspect of the invention, the sender identification information is used to search one or more remote websites for publicly accessible correlated information that is related to the sender. In one embodiment, set forth in Applicant's Detailed Description, the sender information...”**

The Examiner respectfully disagrees with the Applicant's argument as stated above. According to the Applicant's Detailed Description, lines 20-22 on page 3 and lines 4-8, page 5, the remote websites 18 are data service providers. Since the remote websites are called “Internet providers”, according to “Newton's Telecom Dictionary”, the “service providers” do not provide databases and/or data information services free to Internet users. They are privately provided databases or data information services to their subscribers with service charges. Therefore, nowhere in the specification disclosed that the correlated information related to the sender is provided free or publicly by the remote websites. The Applicant is requested to point out wherein the specification disclosed that the remote websites 18 are freely or publicly accessed by Internet users.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Binh K. Tieu whose telephone number is (703) 305-3963 and E-mail address: BINH.TIEU@USPTO.GOV.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Curtis Kuntz, can be reached on (703) 305-4708 and **IF PAPER HAS BEEN**

Art Unit: 2643

**MISSED FROM THIS OFFICIAL ACTION PACKAGE, PLEASE CALL Customer**

**Service at (703) 306-0377 FOR THE SUBSTITUTIONS OR COPIES.**

Any response to this action should be mailed to:

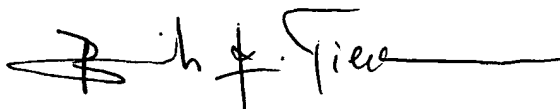
Commissioner of Patents and Trademarks

Washington, D.C. 20231

Or faxed to:

(703) 872-9314

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington VA, Sixth Floor (Receptionist, tel. No. 703-305-4700).

A handwritten signature in black ink, appearing to read "Binh Tieu", with a long horizontal line extending to the right.

**BINH TIEU**  
**PRIMARY EXAMINER**

Art Unit 2643

Date: February 26, 2004